REMARKS

Status of the Claims

Claim 10 is currently amended.
Claims 1-9 and 11-26 have been canceled.
Claims 27-33 have been withdrawn.

Rejection Pursuant to 35 USC §103(a)

Claims 9-11 are rejected under 35 USC 103(a) as being unpatentable over Carter et al WO 98/47890. The office asserts that one having ordinary skill in the art would find the instant species *prima facie* obvious over the reference because not only a detailed description of the generic concept was disclosed by the reference, the well exemplified compounds would guide one skilled in the art to pick and choose the instant claims.

Claims 9 and 11 have been canceled. Applicants reserve the right to file a continuation or divisional application directed to the subject matter of claims 9 and 11.

Claim 10 is still pending and contains the most preferred species of the present invention. All of these compounds exhibited inhibition *in vitro* of COX-2 having an IC_{50} value of less than 0.2μM.

When determining whether one of ordinary skill in the art would have been motivated to select the claimed species one must consider the size of the prior art genus, bearing in mind that size alone cannot support an obviousness rejection. See, e.g., *Baird*, 16 F.3d at 383, 29 USPQ2d at 1552. The genus disclosed by Carter et al contains thousands of species. There are only 29 species claimed by the present invention. One of skill in the art would not have been motivated by Carter et al to choose the specific substitutions encompassed by the present claims.

When evaluating the scope of a claim, every limitation in the claim must be considered. See, e.g., *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Carter et al does not teach every limitation encompassed by the claims. Carter et al does not teach any compounds with the following substitution patters:

6 halo, 7alkoxy, 8 alkyl;
6 halo, 7 alkylthio;
5,7 alkyl, 6 halo; and
5 alkyl, 6,8 halo.

Carter et al does not disclose a single species with an ethylbutoxy, isobutoxy, isobutyl or benzyl substitution. Carter et al does not teach a substitution wherein one of R^1-R^4 is OCF_3 and one of R^1- R^4 is anything other than H. Carter et al does not teach where R^1-R^4 is a disubstituted phenyl or an alkyl substituted phenyl. The specific substitutions in the present claims are not disclosed or taught by Carter et al.

The presumption of obviousness based on a reference disclosing structurally similar compounds may be overcome where there is evidence showing there is no reasonable expectation of similar properties in structurally similar compounds. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). It is believed that one of skill in the art would not be motivated to make a compound with a dialkyl substitution based on the poor IC_{50} values of such compounds in Carter et al. Example 23 of Carter et al discloses a 6,8-bis(1,1-dimethylethyl) substitution which has an IC_{50} value of 24. Example 22 of

Carter et al discloses a compound with a 7,8-dimethyl substitution which has a fast assay IC_{50} value of greater than 100. Claimed compounds of the present invention described in examples 32b and 151 both contain dialkyl substitutions. Example 32b has an IC_{50} value of 0.289 and a fast assay IC_{50} value of 0.265. Example 151 has an IC_{50} value of less than 0.137. In view of Carter et al one of skill in the art would not expect a compound with a dialkyl substitution to be a potent inhibitor of COX-2.

It is believed that an obviousness type rejection is improper and it is requested that such rejection be withdrawn.

Rejection Pursuant to Nonstatutory Obviousness-Type Double Patenting in view of US 6,034,256

Claims 9-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of US patent No. 6,034,256. Without acquiescing to the propriety of this rejection, applicants submit a terminal disclaimer, which is believed sufficient to obviate this rejection.

Rejection Pursuant to Nonstatutory Obviousness-Type Double Patenting in view of US Application No. 10/801,446

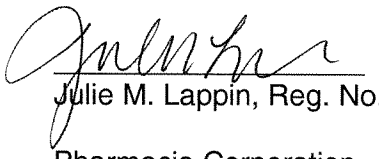
Claims 9-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the elected claims 9-12 of copending application No. 10/801,446 in view of claims 1-27 of US patent No. 6,034,256 and claims 1-2 of US 7,138,411. It is believed that this rejection is premature and should be addressed at a later date when and if such rejection is proper.

Conclusion

It is believed that the claims are in condition for allowance, it is respectfully requested that the application be passed to issue.

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, she is cordially invited to contact Applicant's representative at the below listed number.

Respectfully submitted,



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